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09/900,384	07/06/2001	Shekhar Kirani	8878P010	7192
8791 7590 04/26/2010 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
BENZGZON, GREG C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/900,384

Applicant(s)

KIRANI ET AL.

Examiner

GREG BENZON

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-33 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-33, 46-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SEI/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 02/18/2010

DETAILED ACTION

This application has been examined. Claims 1-16, 18-33, 46-50 are pending.
Claims 17, 34-45, 51 are cancelled.

Making Final

Applicant's arguments filed 02/16/2010 have been fully considered but they are not persuasive.

The claim amendments regarding -- *'link further includes transformation parameters that indicate how to transform the particular attachment to the reformatted attachment and the transformation parameters are based on the capabilities of the intended recipient's receiving device'* -- do not overcome the disclosure by the prior art as applied in the prior Office Action, as shown below.

The Examiner presents an Objection to the Specification as necessitated by the claim amendments.

Furthermore the Examiner is maintaining the rejection(s) using the same grounds for rejection and is thus making this action FINAL.

Response to Arguments

Applicant's arguments filed 02/16/2010 have been considered but are not persuasive.

The Examiner presents an Objection to the Specification as necessitated by the claim amendments.

The Applicant presents the following argument(s) *[in italics]*:

[The prior art does not] teach or suggest a link in an email referencing a reformatted email attachment that includes transformation parameters that "are based on the capabilities of the intended recipient's receiving device."

The Examiner respectfully disagrees with the Applicant.

The Examiner interprets the said limitation according to Applicant Specification Page 37 lines 23-28 wherein the HTTP request includes the URL and transformation parameters. The Examiner notes that the HTTP request is separate and distinct from the URL that is inserted into the email body. In the context required by the claim language, the HTTP request is not embedded into the email body and thus cannot be equivalent to the URL link.

Furthermore the Examiner notes Applicant Specifications Page 36 Lines 10-15, Page 33 Lines 1-40 do not appear to format said URL including transformation parameters.

Rabe-Hesketh disclosed *wherein the request includes an identification of the reformatted attachment (Rabe-Hesketh-Pae 9 Lines 30-35, 'gain access to the attachment by activating the link') .*

Furthermore Moussa Column 6 Lines 50-65 disclosed a client request indicating the client device capabilities wherein said capabilities are used to determine how to reformat the requested content. Moussa disclosed wherein the reformat process is performed for an email attachment.

Bakshi Column 5 Lines 35-45 disclosed an HTTP request indicating a URL and parameters for transcoding the content.

In the combination of Rabe-Hesketh-Moussa-Bakshi it would have been obvious to a person of ordinary skill in the networking art to include the client device capabilities in the request for the accessing the attachment using a URL so that the request format includes both the URL and client device parameters. The motivation for said combination would have been to Rabe-Hesketh's system to enhance its ability and flexibility in providing services to the users that have different levels of resources and capabilities (Moussa-Column 4 Lines 60-65) while removing the need for the reformatting server to interrogate the requesting client device (e.g. in the case of new users of the system).

Thus Rabe-Hesketh-Moussa-Bakshi disclosed *wherein the request includes an identification of the reformatted attachment and wherein the transformation parameters are based on the capabilities of the intended recipient's receiving device.*

Priority

The claimed inventions have been verified with the parent applications 09/588875 filed 6/6/2000 and 60/203407 filed 06/11/2000. The parent applications do not support the claims' subject matter. Hence, they do not entitle this application to a benefit of earliest filing date.

The effective date of the claims described in this application is July 6, 2001.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 02/18/2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claim 1 recites a limitation wherein '*said link further includes transformation parameters that indicate how to transform the particular attachment to the reformatted*

attachment and the transformation parameters are based on the capabilities of the intended recipient's receiving device'.

The Applicant presents Figure 6, block 601, page 16 lines 9-11, and page 37 lines 23-28 as providing support in the Applicant Specifications regarding said limitation. Upon careful review of said portions the Examiner cannot detect clear support or antecedent basis so that the meaning of the terms in the claims may be ascertainable by reference to the description. The Examiner respectfully contends that the cited portions do not indicate wherein a URL contains transformation parameters. Specifically, page 37 lines 23-28 indicate wherein the HTTP request includes the URL and transformation parameters. The Examiner notes that the HTTP request is separate and distinct from the URL that is inserted into the email body. In the context of the claim language, the HTTP request is not embedded into the email body.

Furthermore the Examiner notes Applicant Specifications Page 36 Lines 10-15, Page 33 Lines 1-40 do not appear to format said URL including transformation parameters.

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 18-33 and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabe-Hesketh et al. (WO 00/72534 Applicant) and Moussa et al. (US Patent 6742043) further in view of Bakshi (US Patent 6311215).

Regarding claims 1 Rabe-Hesketh disclosed a method, apparatus and computer program (collectively referred to as "system") for automatically processing e-mail messages containing attachments, the method comprising: receiving a particular e-mail message having a particular attachment; (Rabe-Hesketh –Page 5 Lines 25-35, *'inspect the MIME parts, recognize attachments, and avoid displaying large amounts of attached data'*) removing the particular attachment from the particular message based on predefined criteria e.g., size of the attachment; (Rabe-Hesketh –Page 5 Lines 25-35, *'inspect the MIME parts, recognize attachments, and avoid displaying large amounts of attached data'*) inserting a link into the particular e-mail message, said link capable of

referencing the particular attachment that has been removed;(Rabe-Hesketh-Page 6 Lines 25-35,'recipient is sent an email message including a link to the attachment') in response to invocation of the link by the intended recipient, (Rabe-Hesketh-Pae 9 Lines 30-35,'gain access to the attachment by activating the link') retrieving a copy of the particular attachment that is automatically formatted based on the specified preference.

Rabe-Hesketh does not explicitly disclose specifying a preference for formatting attachments and does not explicitly apply predefined criteria in response to a client's capability, e.g., exceeding client capability. Rabe-Hesketh does not disclose detecting an intended recipient's receiving device during a request from the recipient to retrieve the particular e-mail message and thus formatting attachments accordingly. Rabe-Hesketh does not disclose creating a reformatted attachment based on the specified preference and substituting a link in the email to the reformatted attachment in place of the reformatted attachment

However, in the same field of endeavor, a teaching that has objective akin to Rabe-Hesketh, Moussa teaches a system for communicated media object to an e-mail recipient, which is capable of modifying object format based on specified user preference (Moussa-Column 16 Lines 25-35). Moussa disclosed detecting an intended recipient's receiving device during a request from the recipient to retrieve the particular

e-mail message (Moussa-Column 6 Lines 45-65, Column 16 Lines 25-35) and thus formatting attachments accordingly. (Moussa-Column 16 Lines 35-55)

Moussa disclosed creating a reformatted attachment based on the specified preference (Moussa-Column 6 Lines 45-65, 'receives client capabilities, uses the client capabilities to determine how to reformat the requested web content', Column 16 Lines 25-35, 'wherein the web content is an email attachment').

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Rabe-Hesketh by including, the teaching of using user preference and thinning message to accommodate client capabilities as taught by Moussa to enable Rabe-Hesketh's system to provide an object in accordance with user requirement and expand the predefined criteria in Rabe-Hesketh. In doing would enable Rabe-Hesketh's system to enhance its ability and flexibility in providing services to the users that have different levels of resources and capabilities. (Moussa-Column 4 Lines 60-65)

However the combination of Rabe-Hesketh-Moussa does not disclose substituting a link in the email to the reformatted attachment in place of the reformatted attachment.

The Examiner notes that it would have been obvious to a person of ordinary skill in the art that the reference link inserted by Rabe-Hesketh has a one-to-one correlation

with the original attachment which said link replaces in the email message. Thus, in the combination of Rabe-Hesketh-Moussa where the original attachment is no longer the desired content, it would have been obvious to a person of ordinary skill in the networking art to substitute a link in the email to the reformatted attachment in place of the reformatted attachment.

Furthermore the combination of Rabe-Hesketh-Moussa does not disclose (re. Claim 1) receiving a request for a copy of the reformatted attachment wherein the request includes transformation parameters that indicate how to transform the particular attachment to the reformatted attachment.

Bakshi disclosed (re. Claim 1) receiving a request for a copy of the reformatted attachment wherein the request includes transformation parameters that indicate how to transform the particular attachment to the reformatted attachment. (Bakshi-Column 2 Lines 65 thru Column 3 Lines 1-25, Column 7 Lines 5-40, Column 7 Lines 60 thru Column 8 Lines 15)

At the time of the invention it would have been obvious to combine Bakshi into Rabe-Hesketh-Moussa. The motivation for said combination would have been to allow network client 12 to receive the correctly-transcoded content even if the HTTP remote proxy 36 to which it is coupled changes due to, for example, a change in geographical

location of network client 12 or network load-balancing procedures. (Bakshi- Column 7 Lines 60 thru Column 8 Lines 15)

Rabe-Hesketh-Moussa-Bakshi disclosed (re. Claim 1) *wherein the request includes an identification of the reformatted attachment and wherein the transformation parameters are based on the capabilities of the intended recipient's receiving device."*

Rabe-Hesketh disclosed wherein the request includes an identification of the reformatted attachment (Rabe-Hesketh-Pae 9 Lines 30-35, *'gain access to the attachment by activating the link'*) .

Furthermore Moussa Column 6 Lines 50-65 disclosed a client request indicating the client device capabilities wherein said capabilities are used to determine how to reformat the requested content. Moussa disclosed wherein the reformat process is performed for an email attachment.

Bakshi Column 5 Lines 35-45 disclosed an HTTP request indicating a URL and parameters for transcoding the content.

In the combination of Rabe-Hesketh-Moussa-Bakshi it would have been obvious to a person of ordinary skill in the networking art to include the client device capabilities in the request for the accessing the attachment using a URL so that the request format includes both the URL and client device parameters. The motivation for said combination would have been to Rabe-Hesketh's system to enhance its ability and flexibility in providing services to the users that have different levels of resources and

capabilities (Moussa-Column 4 Lines 60-65) while removing the need for the reformatting server to interrogate the requesting client device (e.g. in the case of new users of the system).

Thus Rabe-Hesketh-Moussa-Bakshi disclosed *wherein the request includes an identification of the reformatted attachment and wherein the transformation parameters are based on the capabilities of the intended recipient's receiving device.*

Claims 4-6, 18, 26, and 46 are rejected on the same basis as Claim 1.

The motivation to combine described in the rejection for Claim 1 applies to Claims 4-6, 18, 26 and 46.

Regarding claims 26 the Examiner notes Rabe-Hesketh-Moussa-Bakshi, in combination with what was well-known in the networking art disclosed '*generating a reference allowing retrieval of a transformed copy of the detached object*'.

The Examiner notes that it would have been obvious to a person of ordinary skill in the art that the reference link inserted by Rabe-Hesketh has a one-to-one correlation with the original attachment which said link replaces in the email message. Thus, in the combination of Rabe-Hesketh-Moussa-Bakshi where the original attachment is no longer the desired content, it would have been obvious to a person of ordinary skill in the networking art to substitute a link in the email to the reformatted attachment in place of the reformatted attachment.

Furthermore Rabe-Hesketh-Moussa-Bakshi disclosed (re. Claim 46) a transformation module for transforming the objects of the attachment to a desired format, based on capabilities of the target device; (Moussa-Column 6 Lines 45-65, Column 16 Lines 45-65).

Regarding claims 2 and 3, Rabe-Hesketh-Moussa-Bakshi disclosed, preference is associated with a particular user (Moussa-Column 6 Lines 45-65).

The motivation to combine described in the rejection for Claim 1 applies to Claims 2-3.

Regarding claims 7, 8 and 27, Rabe-Hesketh-Moussa-Bakshi disclosed preference includes specifying that attachments which comprise images be transformed from one file format to another (Moussa-Column 6 Lines 45-65)

The motivation to combine described in the rejection for Claim 1 applies to Claims 7,8,27.

Regarding claim 9 and 49, Rabe-Hesketh-Moussa-Bakshi disclosed receiving the particular message at an SMTP server (Rabe-Hesketh, Page 4, Lines 21-26).

The motivation to combine described in the rejection for Claim 1 applies to Claims 9,49.

Regarding claim 10-11, Rabe-Hesketh-Moussa-Bakshi disclosed removing attachment could be done at anywhere server including a mail server or at MTA, which employed SMTP protocol. (Rabe-Hesketh, Page 4, Lines 21-26)

Implicitly, Rabe-Hesketh-Moussa-Bakshi has readily taught removing an attachment at SMTP server or by the SMTP server.

The motivation to combine described in the rejection for Claim 1 applies to Claims 10-11.

Regarding claims 12-14, 47-48, Rabe-Hesketh-Moussa-Bakshi disclosed message includes a MIME attachment (Rabe-Hesketh - Page 3, Lines 24-37).

The motivation to combine described in the rejection for Claim 1 applies to Claims 12-14, 47-48.

Regarding claims 15 and 33, Rabe-Hesketh-Moussa-Bakshi disclosed link comprises a Uniform Resource Locator (URL) referencing said attachment that has been removed (Rabe-Hesketh Page 6, Lines 2-8; Page 12, Lines 18-30).

The motivation to combine described in the rejection for Claim 1 applies to Claims 15,33.

Regarding claims 16, 19-20 and 28, Rabe-Hesketh-Moussa-Bakshi disclosed copy of the particular attachment is automatically formatted when a request is received to retrieve the particular attachment (Moussa-Column 6 Lines 45-65)

The motivation to combine described in the rejection for Claim 1 applies to Claims 16, 19-20 and 28.

Regarding claims 21-22, 26,29 , Rabe-Hesketh-Moussa-Bakshi disclosed reformatting resolution, fidelity, color. (Moussa-Column 9 Lines 55-60)

The motivation to combine described in the rejection for Claim 1 applies to Claims 21-22, 26,29.

Regarding claims 23, 30, Rabe-Hesketh-Moussa-Bakshi disclosed formatted copies of objects within the particular attachment are stored in a network repository (Rabe-Hesketh Fig. 2, storage 27).

The motivation to combine described in the rejection for Claim 1 applies to Claims 23,30.

Regarding claim 24, Rabe-Hesketh-Moussa-Bakshi disclosed network repository is accessible by a Web browser for shared access among multiple participants (Rabe-Hesketh Fig4, 48; Fig 5A-5C).

The motivation to combine described in the rejection for Claim 1 applies to Claims 24.

Regarding claims 25, 31 and 32, Rabe-Hesketh-Moussa-Bakshi disclosed attachment includes JPEG-formatted digital images (Moussa-Figure 6).

The motivation to combine described in the rejection for Claim 1 applies to Claims 25,31,32.

Rabe-Hesketh-Moussa-Bakshi disclosed (re. Claim 50) wherein said attachment

processing module operates as a plug-in module to said e-mail server. (Rabe-Hesketh-
Page 21 Lines 15-25, Page 22 Lines 30-35)

The motivation to combine described in the rejection for Claim 1 applies to
Claims 50.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TAMMY THANH NGUYEN/
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/G. B./
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